

REMARKS

This responds to the Office Action mailed on August 10, 2007.

Claims 1, 5, 8, 13, 15, 20, 21, and 28 are amended, no claims are canceled, and no claims are added; as a result, claims 1-29 are now pending in this application.

Claim Objections

Claims 5, 15, 20 and 28 were objected to for informalities. Specifically, “they do not end with a period” (Office Action, page 2).

In response to the objection, claims 5, 15, 20 and 28 have been amended.

Claims 15 was objected to for omitting a preposition “to.” (*Id.*).

In response to the objection, claim 15 is amended.

§112 Rejection of the Claims

Claim 8 was rejected under 35 U.S.C. § 112, second paragraph, for indefiniteness. Specifically, claim 8 was rejected for the reason that “it is not clear what the limitation ‘in a manner that is transparent to the consumer user’ means” (*Id.*).

In response to the object, claim 8 is amended to clarify the meaning of “transparent.”

§102 Rejection of the Claims

Claims 1-4, 6-8, 13, 16 and 21 were rejected under 35 U.S.C. § 102(b) for anticipation by Bartoli (U.S. 6,047,268; hereinafter Bartoli).

Applicants respectfully submit that the rejection of the claims 1-4, 6-8, 13, 16 and 21 under 35 U.S.C. § 102(b) is defective for the reason that Bartoli does not disclose each and every limitation of the independent claims 1, 13, and 21 of the present application.

To anticipate a claim, the reference must teach every element of the claim.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." ¹

¹ Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, USPQ2d 1051, 1053 (Fed. Cir. 1987)

Applicants believe that the issue of patentability over Bartoli is best be understood with regard to claim 1.

Claim 1, as amended, includes the following limitation:

serving a web-based check-out interface, hosted by the electronic storefront, to a browser client used by the consumer user,

the check-out interface including an option to enable the consumer user to make payment for the one or more products via the payment service if it is determined the user is authorized to use the payment service.

The Office Action relies upon the following quote from Bartoli which fails to disclose a check-out interface including an option to enable the consumer user to make payment for one or more products via a payment service if it is determined the user is authorized to use the payment service.

The billing server then sends to the user's browser a new cookie which contains the user's account identity in the static information portion and a new transaction oriented dynamic portion to be used by the user's browser for authentication of the user for a next transaction.

Bartoli, Col. 2, lines 61-65 (first quote).

The billing server either after each transaction, or on a periodic basis, sends the transaction summary to a billing platform for billing of the user based on his or her registered billing preference such as a telephone bill, credit card charge, or a direct invoice. The billing platform then settles with the merchant after a fixed number of days, contingent on the user paying his or her bill.

Bartoli, Col. 3, lines 8-12 (second quote).

The above quotes from Bartoli relate to a billing server. The first quote relates the billing server as sending a new cookie to a client browser. The new cookie is used to authenticate the

user for a next transaction. The second quote relates to the billing server initiating the billing of a user.

Claim 1 requires serving a web-based check-out interface, hosted by an electronic storefront, to a browser client used by a consumer user, the check-out interface including an option to enable the consumer user to make payment for one or more products via a payment service if it is determined the user is authorized to use the payment service. In contrast, the above quotes from Bartoli relate to a billing server that sends a cookie to a client browser for a next transaction and the billing server initiating the billing of the user. Clearly neither the first nor the second quotes from Bartoli disclose serving a check-out interface hosted by an electronic storefront, much less a check-out interface that includes an option to enable the consumer user to make a payment for one or more products via a payment service, nor, the serving of the check-out interface responsive to a determination that the user is authorized to use the payment service.

Generally, Bartoli relates to a system for billing for transactions over the Internet. The billing system operates as follows. In response to an intent of a user to purchase a selected item and an intent of the user to be billed via a billing system, a merchant's order is sent to the billing system. In response, the billing system attempts to authenticate the user. Responsive to successful authentication of the user, the billing system authorizes the transaction and sends a cookie to the browser of the user. Responsive to receiving the cookie, the user's browser program provides the user an opportunity to reject or finally approve of the transaction. If finally approved, the order is sent to the merchant's server via the user's client terminal browser program which posts the completed transaction information to the billing server for billing.

The above billing system as related by Bartoli operates in way that is fundamentally different from the method required by claim 1. Specifically, Bartoli relates a user as intending to be billed via a billing system before the billing system authenticates the user. In contrast, claim 1 requires serving an interface that includes an option to enable the consumer user to make a payment for products via a payment service responsive to a determination that the user is authorized to use the payment service. Accordingly, claim 1 requires the authorization to precede the serving of the interface because the serving of the interface is responsive to the authorization. Clearly Bartoli operates differently. Accordingly, Bartoli cannot be said to anticipate the above quoted limitation of claim 1.

In summary, because Bartoli does not disclose each and every limitation of claim 1, the Office Action fails to make a *prima facie* showing of anticipation as is required to support a rejection of this claim under 35 U.S.C. § 102(b).

The above remarks are also applicable to a consideration of independent claims 13, 17, and 21.

As dependent claims are deemed to include all limitation of claims from which they depend, the rejection of claims 2-4, 6-8, 16 and 21 under 35 U.S.C. § 102(e) is also addressed by the above remarks, and the amendments contained herein.

§103 Rejection of the Claims

Claims 5, 14-15 and 22-24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Bartoli. Specifically, the Office Action takes Official Notice that the subject matter of claims 5, 14-15, 22 and 24 are notoriously old and well known in the art.

103 Rejections based on Official Notice

Applicants respectfully traverse the finding of the subject matter of the claims 5, 10, 11, 13, 15, 17, 19, 22, 24, 25, 27 and 29 as being notoriously old and well known in the art.

In regard to a finding that properly substantiates the taking of Official Notice, the MPEP states the following:

Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known.²

In addition, a court has stated the following:

The notice of facts beyond the record which may be taken by the examiner must be capable of such instant and unquestionable demonstration as to defy dispute.³

² MPEP 2144.03

³ *In re Ahlert*, 424 F.2d 1088, 1091 165 USPQ 4189 420 (CCPA 1970)

In response to the taking of Official Notice for claims 5, 10, 11, 14-15, 17, 19, 22, 24, 25, 27 and 29, Applicants submit that the state of the art of electronic commerce with regard to specific and detailed payment service features found in the aforementioned claims as of any specific date is subject to rational disagreement among reasonable men and is not amenable to the taking of such notice. Moreover, limitations recited in dependent claims must be combined with the limitations of the independent claims on which they depend for the reason that novelty and non-obviousness may be found in a specific combination of limitations.

In response to the taking of Official Notice for claims 5, Applicants submit that providing a merchant ID to a payment service via a URL (uniform resource locator), as required by claim 5, is not instantly and unquestionably demonstrable as being well-known because the notoriety of such knowledge as of the priority date of the present application, March 21, 2003, is subject to dispute. Applicants timely object to such reliance on Official Notice, and requests the Examiner to provide a reference or affidavit in support of such assertion, as required by MPEP § 2144.03.

In response to the taking of Official Notice for claim 10, Applicants submit that storing information at the payment service web site identifying a return URL (uniform resource locator) corresponding to the third web page; extracting a return URL embedded in the information to redirect the browser client to the web page hosted by the payment service web site; and comparing the return URL that is extracted to the return URL corresponding to the third web page to determine whether redirection to the third web page should be performed, as required by claim 10, is not instantly and unquestionably demonstrable as being well-known because the notoriety of such knowledge as of the priority date of the present application, March 21, 2003, is subject to dispute. Applicants timely object to such reliance on Official Notice, and requests the Examiner to provide a reference or affidavit in support of such assertion, as required by MPEP § 2144.03.

In response to the taking of Official Notice for claim 11, Applicants submit that embedding information in the URL to the third web page indicating whether the user is authorized to use the payment service, as required by claim 11, is not instantly and unquestionably demonstrable as being well-known because the notoriety of such knowledge as of the priority date of the present application, March 21, 2003, is subject to dispute. Applicants

timely object to such reliance on Official Notice, and requests the Examiner to provide a reference or affidavit in support of such assertion, as required by MPEP § 2144.03.

In response to the taking of Official Notice for claim 14, Applicants submit that the combination of redirecting a browser to a payment service web site and the information identifying a merchant as sent by 1) generating a uniform resource locator containing an embedded merchant identifier and 2) sending the URL to the browser, as required by claim 14, is not instantly and unquestionably demonstrable as being well-known because the notoriety of such knowledge as of the priority date of the present application, March 21, 2003 is subject to dispute. Applicants timely objects to such reliance on Official Notice, and requests the Examiner to provide a reference or affidavit in support of such assertion, as required by MPEP § 2144.03.

In response to the taking of Official Notice for the claim 15, Applicants submit that embedding a return URL within a URL used to redirect the browser to the payment service web site, the return URL to redirect the browser to a first web page in a check-out flow, as required by claim 15, is not instantly and unquestionably demonstrable as being well-known because the notoriety of such knowledge as of the priority date of the present application, March 21, 2003, is subject to dispute. Applicants timely objects to such reliance on Official Notice, and request the Examiner to provide a reference or affidavit in support of such assertion, as required by MPEP § 2144.03.

In response to the taking of Official Notice for the claim 17, Applicants submit that extracting a merchant identifier (ID) from a URL (uniform resource locator) used to direct a browser to a payment service web site, the merchant identifier corresponding to an operator of an electronic storefront, as required by claim 17, is not instantly and unquestionably demonstrable as being well-known because the notoriety of such knowledge as of the priority date of the present application, March 21, 2003, is subject to dispute. Applicants timely objects to such reliance on Official Notice, and request the Examiner to provide a reference or affidavit in support of such assertion, as required by MPEP § 2144.03.

In response to the taking of Official Notice for the claim 19, Applicants submit that extracting a return URL embedded in the URL used to direct a browser to a payment service web site; and determining if the return URL that is extracted matches a return URL the merchant has registered with the payment service, as required by claim 19, is not instantly and unquestionably

demonstrable as being well-known because the notoriety of such knowledge as of the priority date of the present application, March 21, 2003, is subject to dispute. Applicants timely objects to such reliance on Official Notice, and request the Examiner to provide a reference or affidavit in support of such assertion, as required by MPEP § 2144.03.

In response to the taking of Official Notice for claim 22, Applicants submit that embedding a merchant identifier in a URL (uniform resource locator) used to redirect the browser to the payment service web site, as required by claim 22, is not instantly and unquestionably demonstrable as being well-known because the notoriety of such knowledge as of the priority date of the present application, March 21, 2003, is subject to dispute. Applicants timely object to such reliance on Official Notice, and request the Examiner to provide a reference or affidavit in support of such assertion, as required by MPEP § 2144.03.

In response to the taking of Official Notice for claim 24, Applicants submit that embedding a return uniform resource locator within a uniform resource locator used to redirect the browser to the payment service web site, the return uniform resource locator to redirect the browser to the web page containing or not including the option to make a purchase using the payment service, as required by claim 24, is not instantly and unquestionably demonstrable as being well-known because the notoriety of such knowledge as of the priority date of the present application, March 21, 2003, is subject to dispute. Applicants timely object to such reliance on Official Notice, and request the Examiner to provide a reference or affidavit in support of such assertion, as required by MPEP § 2144.03.

In response to the taking of Official Notice for the claim 25, Applicants submit that extracting a merchant identifier (ID) from a URL (uniform resource locator) used to direct a browser to a payment service web site, the merchant identifier corresponding to an operator of an electronic storefront, as required by claim 25, is not instantly and unquestionably demonstrable as being well-known because the notoriety of such knowledge as of the priority date of the present application, March 21, 2003, is subject to dispute. Applicants timely objects to such reliance on Official Notice, and request the Examiner to provide a reference or affidavit in support of such assertion, as required by MPEP § 2144.03.

In response to the taking of Official Notice for the claim 27, Applicants submit that extracting a return URL embedded in the URL used to direct a browser to a payment service web

site; and determining if the return URL that is extracted matches a return URL the merchant has registered with the payment service, as required by claim 27, is not instantly and unquestionably demonstrable as being well-known because the notoriety of such knowledge as of the priority date of the present application, March 21, 2003, is subject to dispute. Applicants timely objects to such reliance on Official Notice, and request the Examiner to provide a reference or affidavit in support of such assertion, as required by MPEP § 2144.03.

In response to the taking of Official Notice for the claim 29, Applicants submit that wherein at least a portion of the instructions are embodied as a common gateway interface (CGI) script, as required by claim 29, is not instantly and unquestionably demonstrable as being well-known because the notoriety of such knowledge as of the priority date of the present application, March 21, 2003, is subject to dispute. Applicants timely objects to such reliance on Official Notice, and request the Examiner to provide a reference or affidavit in support of such assertion, as required by MPEP § 2144.03.

103 Rejection based on 102 Rejection

Claim 23 depends on independent claim 21. Agrawal does not supply the elements of the independent claim 1 that was shown above to be missing from Bartoli. Specifically, Agrawal does not disclose serving a web-based check-out interface hosted by the electronic storefront, as required by claim 1. If an independent claim is not anticipated under 35 U.S.C. § 102 then, any claim depending therefrom is nonobvious and rejection of claim 23 under 35 U.S.C. § 103 is also addressed by the above remarks.

103 Rejections in view of Agrawal

Claims 9-12, 17-20 and 25-29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Bartoli in view of Agrawal (U.S. Publication No. 2004/0098313 A1; hereinafter Agrawal).

Applicants respectfully submit that the rejection of claims 9-12, 17-20 and 25-29 under 35 U.S.C. § 103 is defective for the reason that prior art references when combined do not teach or suggest all of the claim limitations of the independent claims of the present application.

Applicable Law

In rejecting claims under 35 U.S.C. §103, the Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. *See* M.P.E.P. §2142.

In the recent decision of the Supreme Court on *KSR Int'l Co. v. Teleflex Inc.*⁴, the analysis of obviousness previously set forth in *Graham v. John Deere Co. of Kansas City*⁵, was reaffirmed. The Court in *Graham* set out an objective analysis for applying §103 as follows:

"Under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined."⁶

When claim elements are found in more than one prior art reference, the fact finder must determine "whether a person of ordinary skill in the art, possessed with the understandings and knowledge reflected in the prior art, and motivated by the general problem facing the inventor, would have been led to make the combination recited in the claims." *In re Kahn*⁷. In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co. of Kansas City*⁸.

Further, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*⁹. "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*¹⁰.

⁴ 127 S.Ct. 1727, 82 USPQ2d 1385 (2007).

⁵ 383 U.S. 1, 17, 86 S.Ct. 684, 15 L.Ed.2d 545 (1966).

⁶ The Court in *KSR v. Teleflex*, at page 1730, quoted the analysis of *Graham* from page 18.

⁷ 441 F.3d 977, 988, 78 USPQ2d 1329, 1337 (Fed. Cir. 2006).

⁸ 383 U.S. 1 at 467.

⁹ 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

¹⁰ 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Office personnel must rely on the applicant's disclosure to properly determine the meaning of the claims. *Markman v. Westview Instruments*¹¹.

Agrawal generally relates to detection of fraudulent associate-based transactions. Agrawal specifically relates to an authorization token, however, such a token is used to determine whether a transaction is fraudulent. Accordingly, Agrawal cannot provide what is lacking in Bartoli.

Applicants believe that the issue of patentability over Agrawal is best be understood with regard to claim 17.

Claim 17 includes the following limitation:

...a payment service website...

generating a return URL to redirect the browser to a first web page in a check-out flow hosted by the electronic storefront ...

The Office Action, in rejecting claim 17, contends that the above limitation is taught/suggested by the following as related by Agrawal:

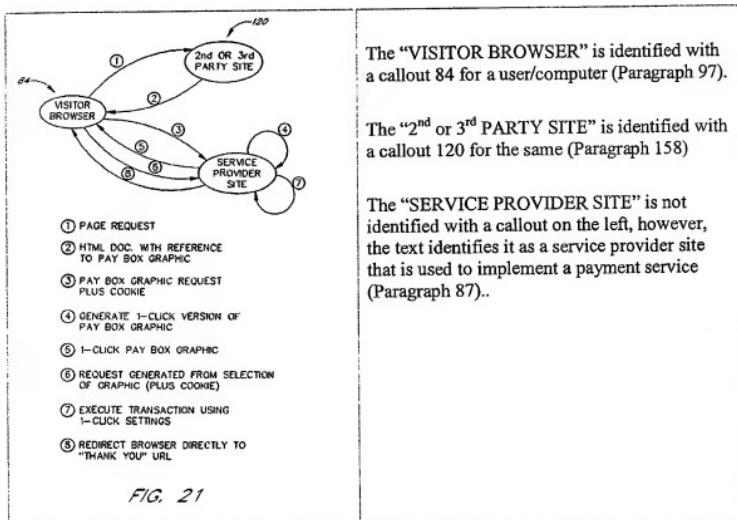
....the site 66 responds to this request by (1)and (2) redirecting the browser to the owner-specified "thank you" URL (event 8). This URL may, for example, be a page of the pay page owner's external web site. The visitor's browser could alternatively be redirected back to the external page from which the payment was initiated, in which case this page may then be displayed with an SP-served display object containing a payment confirmation message (e.g., "you just paid \$1 to ContentProvider.com").

Agrawal, page 13, paragraph 171, lines 4-9

The above quote from Agrawal relates to redirection of a browser to a "thank you" URL. The "thank you" URL may be a page of an external web site. The external web site may be associated with an owner of a pay page. Alternatively, the browser may be directed back to an external page from which payment was initiated. In this case the SP (payment service provider) may be display an object containing a payment confirmation message.

¹¹ 52 F.3d 967, 980, 34 USPQ2d 1321, 1330 (Fed. Cir.) (*en banc*), *aff'd*, U.S., 116 S. Ct. 1384 (1996).

Agrawal relates the following illustration in support of the above text. Specifically, the “event 8” mentioned above is illustrated in the Figure below:

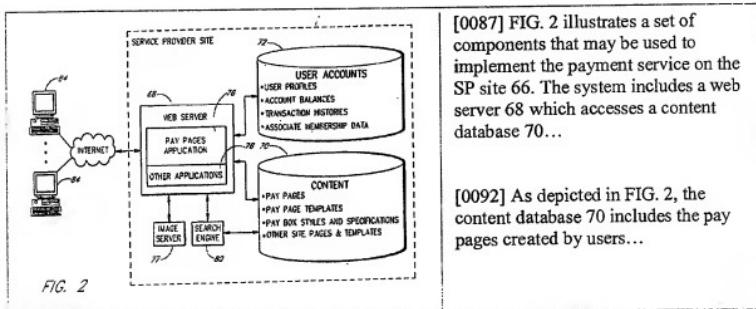


Agrawal, paragraphs 97, 158 and 87

Claim 17 requires generating a return URL to redirect the browser to a first web page in a check-out flow hosted by the electronic storefront and a payment service website. Assuming merely for the sake of argument that the “return URL” of claim 17 is analogous with the “Thank You” URL in the above quote from Agrawal and the “first web page in a check-out flow” of claim 17 is analogous with “a page of the pay page owner’s external web site” or, alternatively, an “external page from which the payment was initiated” then the above from Agrawal fails to disclose redirection of a browser to a first web page in a check-out flow hosted by the electronic

storefront, as required by claim 17. Specifically, Agrawal relates "pay pages" that are hosted by the "service provider site 66" and not the 2nd or 3rd PARTY SITE 120.

To be sure, Agrawal relates the following:



Agrawal, Figure 2, paragraphs 87 and 92

The above Figure and quotes from Agrawal relate a service provider (SP) site 66 that may be used to implement a payment service. The SP site 66 includes a web server 68 which accesses a content database 70 that includes "pay pages."

Agrawal defines a Pay page as follows:

[0057] Pay page--A custom page or screen through which an associated user (the "payee" or pay page "owner") can receive payments from other users. Typically, a pay page includes information about its owner. Pay pages are persistent, meaning that a given pay page may be used to receive many separate payments over time (from the same or different users). In one embodiment, payees can create pay pages for a variety of different types of payment scenarios (using corresponding pay page templates), such as general-purpose payments, charitable donations, and invoice payments.

In contrast, claim 17 requires redirection of a browser to a first web page in a check-out flow hosted by an electronic storefront. Agrawal therefore cannot be said to teach or suggest the above quoted limitation because Agrawal relates “pay pages” that are hosted by a payment service provider site used to implement a payment service and claim 17 requires redirection to a check-out flow hosted by an electronic storefront and a payment service website. These are distinguishable actions.

Bartoli relates a system for billing for transactions over the Internet. “Bartoli does not show redirecting the browser to first web page in a check-out flow hosted by the electronic storefront if the merchant is authenticated, the check-out flow including an option to purchase products from the electronic storefront via the payment service” (Office Action, page 14). Accordingly, Bartoli cannot provide what is lacking in Agrawal.

The above remarks are also applicable to a consideration of independent claim 25.

Claims 26-29 depend on independent claim 25 and claims 18-20 depend on independent claim 17. If an independent claim is nonobvious under 35 U.S.C. § 103 then, any claim depending therefrom is nonobvious and rejection of claims 26-29 and 18-20 under 35 U.S.C. § 103 is also addressed by the above remarks.

In summary, Bartoli, whether considered separately or in combination with Agrawal, fails to teach or suggest each and every limitation of independent claims 1, and 4, 20, 23, 41, and 42 as is required to support a *prime facie* case of obviousness in rejecting of the independent claims of the present application under 35 U.S.C. § 103.

103 Rejection based on 102 Rejection

Claims 9-12 depend on independent claim 1. Agrawal does not supply the elements of the independent claim 1 that was shown above to be missing from Bartoli. Specifically, Agrawal does not disclose serving a web-based check-out interface hosted by the electronic storefront, as required by claim 1. If an independent claim is not anticipated under 35 U.S.C. § 102 then, any claim depending therefrom is nonobvious and rejection of claims 9-12 under 35 U.S.C. § 103 is also addressed by the above remarks.

RESERVATION OF RIGHTS

In the interest of clarity and brevity, Applicants may not have addressed every assertion made in the Office Action. Applicants' silence regarding any such assertion does not constitute any admission or acquiescence. Applicants reserve all rights not exercised in connection with this response, such as the right to challenge or rebut any tacit or explicit characterization of any reference or of any of the present claims, the right to challenge or rebut any asserted factual or legal basis of any of the rejections, the right to swear behind any cited reference such as provided under 37 C.F.R. § 1.131 or otherwise, or the right to assert co-ownership of any cited reference. Applicants do not admit that any of the cited references or any other references of record are relevant to the present claims, or that they constitute prior art. To the extent that any rejection or assertion is based upon the Examiner's personal knowledge, rather than any objective evidence of record as manifested by a cited prior art reference, Applicants timely object to such reliance on Official Notice, and reserves all rights to request that the Examiner provide a reference or affidavit in support of such assertion, as required by MPEP § 2144.03. Applicants reserve all rights to pursue any cancelled claims in a subsequent patent application claiming the benefit of priority of the present patent application, and to request rejoinder of any withdrawn claim, as required by MPEP § 821.04.

AMENDMENT AND RESPONSE UNDER 37 CFR § 1.111

Serial Number: 10/749,684

Filing Date: December 31, 2003

Title: METHOD AND ARCHITECTURE FOR FACILITATING PAYMENT TO E-COMMERCE MERCHANTS VIA A PAYMENT SERVICE

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Dkt: 2043.034US1

CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicants' attorney at 408-278-4046 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 13th day of November, 2007.

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